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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,835	12/18/2001	Kazuyuki Sato	Q66019	4395

7590 04/25/2005
Sughrue Mion Zinn Macpeak & Seas
2100 Pennsylvania Avenue NW
Washington, DC 20037-3202

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,835

Applicant(s)

SATO ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 to 4, 6 to 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 to 4, 6 to 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2 - 4 and 6 - 11 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/26254, as interpreted by the English language equivalent Mohri et al.

WO 96/26254 is in Japanese and is an extremely long (105 pages) reference. In an effort to reduce unnecessary paper waste, the Examiner is providing only a copy of the front page (abstract) of this reference at this time. A full copy is not necessary to follow this rejection. A copy can easily be provided if applicants request. The Examiner notes that this rejection is over the WO reference rather than the Mohri et al. reference per se because the latter qualifies as prior art only under 35 USC 102(e).

Mohri et al. teach a stain proofing agent which comprises the compound shown as formula (1). See for instance column 2. This compound is added to a resin to form a coating composition. As can be seen from column 14, lines 23 to 25, fluorine containing copolymers having hydroxyl and/or carboxyl groups are preferred. This meets claimed component (C) as well as the specific requirements of claims 6 and 7. Column 25, lines 22 and on, teach various substrates to be coated, meeting claim 8.

The compound (1) in Mohri et al. can contain fluorinated R¹ groups. Such a compound can be prepared by the reaction between a silicate (a metal alkoxide meeting (A) and claim 4 as well) and a fluorinated alcohol, as shown on column 6, lines 41 and on, and Preparation Examples 2 to 7 and 12 to 15. Thus compounds meeting claimed component (A) and (B) are preliminary reacted prior to mixing with compound (C). In this manner the teachings of Mohri et al. meet each of the components (A) to (C) found in claims 2 and 9. The instant claims are open to a composition in which (A) and (B) are first reacted, followed by (C) since there is no limitation on the order of mixing ingredients.

To further support the Examiner's position, she draws attention to Applicants' comments filed 12/16/04 that "it is the combination of the metal alkoxide and a specific

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fluorine containing compound containing a *functional group reactive with the metal alkoxide* that unexpectedly provides enhanced properties". Applicants indicate that (A) and (B) react with one another.

On the other hand, the Examiner draws attention to the teachings on column 22, lines 54 to 60, which states that lower fluorinated alcohols are preferred solvents. Thus a coating composition containing the stain proofing agent (1) and resin in Mohri et al. can contain, as a preferred solvent, a fluorine containing compound that meets (B) as claimed. In this manner too Mohri et al. anticipate a composition containing (A), (B) and (C) as claimed.

With regard to instant claim 3, note that "n" can be 1 to 20, which corresponds to a number of alkoxy groups meeting that claimed. For instance when "n" is 1, a value that is specifically delineated by Mohri et al, the number of alkoxy groups will be 4, falling with in the claimed range. The preferred "n" value of 4 (column 3, line 43) will result in 10 alkoxy groups, falling within the claimed range. See also the Preparation Examples 2 and 12, which meet the claimed range.

For claim 10, see column 21, lines 3 to 5 and lines 37 to 40. Note too working examples 130 to 136, which include a chelate compound. For claim 11, there are numerous compounds in Mohri et al which meet this requirement, since the monomer (D) can be polymerizable with anything. For instance the silane coupling agents on column 25 and in Examples 132 and 133 meet this requirement. The numerous curing agents starting on column 20 meet this requirement.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 2 to 4 and 6, 8 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 to 4 and 6 of U.S. Patent No. 6,811,854. Although the conflicting claims are not identical, they are not patentably distinct from each other because (A) and (E) in '854 correspond to (A) and (B) in the instant claims (claim 6 in '854 teaches the specific X reactive group of (B)) and the polymer (D) in '854 is within the scope of the polymer (C) in claims 2 and 9 (the acid group in (D) is within the breadth of reactive groups in claims 6). Instant claims 3 and 4 correspond to claims 3 and 4 in '854.

5. Claims 10 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,811,854 in view of Mohri et al. Mohri et al. teach a composition that contains a metal alkoxide and a polymer that can comprise repeating units derived from a methacrylic acid derivative. See for instance Example 131. This reference teaches the addition of a metal chelate in an effort to improve the cure of the composition (column 21, lines 35 to 40, as well as Example 131), as well as the addition of polymerizable monomers such as coupling silanes (taught on the top of column 25, as well as Example 131) in an effort to improve adhesion. Thus the skilled artisan would have found the addition of such known components to the composition of '854, in an effort to improve curing and adhesion, to have been obvious over the teachings of Mohri et al.

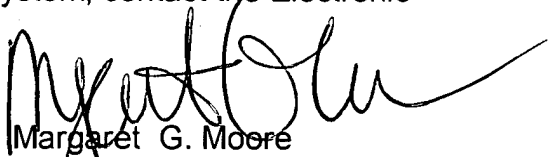
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6. Ito et al. and Zisman et al. are cited as being of general interest. Zisman teaches various fluorine containing compounds meeting (B). Ito teaches primers containing at least one of a metal compound or resin and a fluorine containing compound.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
4/20/05